REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 7, and 10-35 are pending in the present application, Claims 1, 14, 21, and 26 having been amended, and Claims 3-6, 8, and 9 having been previously canceled without prejudice or disclaimer. Support for the amendment to Claims 1, 14, 21, and 26 is found, for example, in the specification at page 8, lines 22-25. Support for new Claims 33-35 is found, for example in Claim 2. Thus, no new matter is added.

In the outstanding Office Action, Claim 30 was objected to; Claim 30 was rejected under 35 U.S.C. §112, second paragraph; Claims 1, 2, 7, 10-12, 14-17, and 21-31 were rejected under 35 U.S.C. §102(b) as anticipated by Richard, III (U.S. Patent No. 5,654,751, hereinafter Richard); and Claim 13 was rejected under 35 U.S.C. §103(a) as unpatentable over Richard in view of Wei et al. (U.S. Patent No. 6,515,967, hereinafter Wei); and Claims 18 and 20 were rejected under 35 U.S.C. §103(a) as unpatentable over Richard.

With respect to the objection to Claim 30 and the rejection of Claim 30 under 35 U.S.C. §112, second paragraph, Claim 30 was amended as suggested in the outstanding Office Action in the response filed October 11, 2005. Thus, the objection to Claim 30 and the rejection of Claim 30 under 35 U.S.C. §112, second paragraph are overcome.

Claim 1 is directed to an apparatus for diagnosis of video device performance in transferring audio visual data over a video network. The apparatus includes a physical network interface operable to receive audio visual data associated with the video device. A diagnostic tool is operable to access the audio visual data as the audio visual data travels over the video network. A diagnostic engine is interfaced with the diagnostic tool and is operable to determine performance statistics by analysis of the audio visual data accessed with the diagnostic tool. The diagnostic tool is further operable to analyze the audio visual data at a

network layer. Analysis of the audio visual data at a network layer to provide performance statistics allows for real time monitoring and diagnosis of video devices.[1]

Turning now to the rejections based on art, Applicants respectfully traverse the rejection of Claim 1 as anticipated by Richard. Claim 1 recites, *inter alia*, "wherein the diagnostic tool is further operable to analyze the audio visual data at a network layer." Richard does not describe or suggest, at least this element of Claim 1.

Richard describes a testing jig or testing circuit board to test the operation of a decoder in a set-top box of an entertainment device. The testing jig, as shown in Fig. 6, interfaces with an encoder to facilitate analysis of the digital video output of the encoder and performance of the decoder.[2]

Richard does not describe or suggest analyzing audio visual data at a network layer. Richard merely discloses that a TV set or any kind of analog test device is connected to the output of the decoder 402 to conduct analysis and/or visual testing. The testing jig can run any signal tests that are standard to the analog testing of NTSC.[3] Analysis and/or visual testing do not describe or suggest that the audio visual data is accessed at a network layer.

Richard also discloses that the testing jig, when mobile, may be used to determine if there is any cell loss by testing the ATM switch fabric.[4] ATM operates at data link layer of the OSI model and not at the network layer.[5]

In view of the above-noted distinctions, Applicants respectfully submit that Claim 1 (and its dependent Claims 2-13, and 32) patentably distinguish over Richard. Amended Claims 14, 21, and 26 are similar to amended Claim 1. Applicants respectfully submit that

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[1] Specification, page 8, lines 22-25.
[2] Richard, col. 5, lines 35-40.
[3] Richard, col. 10, lines 43-46.
[4] Richard, col. 6, lines 13-15.
[5] See attachment, Computer Desktop Encyclopedia, © 1999 The Computer Language Co., Inc, available at http://www.reed-electronics.com/commvergemag/index.asp?layout=term&term=ATM on November 15, 2005.

Claims 14, 21, and 26 (and Claims 15-20, 22-25, and 27-31) patentably distinguish over

Richard for at least the reasons given for amended Claim 1.

With respect to the rejection of Claims 18, 20, and new Claims 32-35, Applicants note

that Richard does not expressly disclose monitoring latency, throughput, or lip synch. The

outstanding Office Action merely concludes that Richard's statement of "This will permit the

tying of certain performance anomalies to known causes such as jitter, packet loss, ATM

mapping variants, etc"[6] means that "it would have been obvious to one of ordinary skill in

the art to monitor all parameters involved in A/V communication which may be subject to

negative effects.[7] However, Richard is only concerned about "certain" parameters and does

not teach or suggest monitoring all parameters. Furthermore, there is no support provided for

the subjective conclusion that "since Richard accounts for synchronization problems such as

jitter, it would therefore have obvious to monitor mutual synchronization between the audio

and video components (i.e. lip synching) and latency, and accordingly provide

countermeasures therefore."[8] Thus, Applicants submit it is only through an impermissible

hindsight reconstruction of Applicants' invention that the rejection of Claims 18 and 20 can

be understood.[9]

In this regard, it is noted that substitution of an improper subjective conclusion as to

knowledge in the art for concrete evidence of such knowledge relative to a core factual

finding required for a determination of patentability is clearly improper. See In re Zurko, 59

USPQ2d 1693, 1697-98 (Fed. Cir. 2001) as follows:

> Finally, the deficiencies of the cited references cannot be
> remedied by the [PTO's] general conclusions about what is
> "basic knowledge" or "common sense" to one of ordinary skill

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[6] Richard, col. 6, lines 43-47, emphasis added.
[7] Office Action, page 5, paragraph 6.
[8] Id.
[9] MPEP § 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art."

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> in the art. As described above, the [PTO] contended that even if
> the cited UNIX and FILER2 references did not disclose a
> trusted path, "it is basic knowledge that communication in
> trusted environments is performed over trusted paths" and,
> moreover, verifying the trusted command in UNIX over a
> trusted path is "nothing more than good common sense." *Ex
> parte Zurko*, slip op. at 8. We cannot accept these findings by
> the [PTO]. This assessment of basic knowledge and common
> sense was not based on any evidence in the record and,
> therefore, lacks substantial evidence support. As an
> administrative tribunal, the [PTO] clearly has expertise in the
> subject matter over which it exercises jurisdiction. This
> expertise may provide sufficient support for conclusions as to
> peripheral issues. With respect to core factual findings in a
> determination of patentability, however, the [PTO] cannot
> simply reach conclusions based on its own understanding or
> experience — or on its assessment of what would be basic
> knowledge or common sense. Rather, the [PTO] must point to
> some concrete evidence in the record in support of these
> findings. [Emphasis added.]

The even more recent Lee decision by the Federal Circuit Court of Appeals (In re Lee,

61 USPQ2d, 1430, 1435 (2002)) is noted to emphasize the need for the PTO to provide actual

evidence on the record, not mere unsupported opinion, as follows:
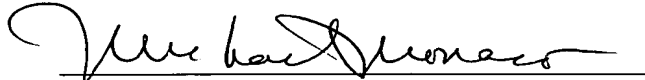
> In finding the relevant facts, in assessing the significance of the
> prior art, and in making the ultimate determination of the issue
> of obviousness, the examiner and the Board are presumed to act
> from this viewpoint [that of the person of ordinary skill in the
> art to which the subject matter pertains]. Thus when they rely
> on what they assert to be general knowledge to negate
> patentability, that knowledge must be articulated and placed on
> the record. [Emphasis added.]

The Lee court further specifically found it to be erroneous and arbitrary conduct for

the PTO to attempt to resolve questions material to patentability by reliance upon "subjective

belief and unknown authority" (see In re Lee at 61 USPQ2d 1434) as is being done here.

Also note the Kotzab court admonition (at 55 USPQ2d 1317) that "[b]road conclusory

statements are not evidence."

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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